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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/246,307	02/08/99	KOZIKOWSKI	99-28-0005-59

020582
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HM12/0509

GUPTA, A	EXAMINER
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ART UNIT 1652	PAPER NUMBER
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DATE MAILED: 05/09/00⁵

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/246,307

Applicant(s)
Kozikowski et al.

Examiner
Anish Gupta

Group Art Unit
1653



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-72 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-72 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-32 and 71-72 drawn to compounds, composition and methods of uses wherein X is S, O, or NR and zero, classified in class 546, subclass 114-115.
 - II. Claims 33-52, 57-58, and 61-65, drawn to compounds, composition, and methods of use wherein the compound is a di-peptide, classified in class 514, subclass 19.
 - III. Claims 53-56, 59-60, and 66-70, drawn to compounds compositions, and methods of use wherein the compound is defined as a dipeptide conjugated to a heterocyclic via a disulfide bridge, classified in class 514, subclass 19.
2. The inventions are distinct, each from the other because of the following reasons:
3. The compound of Group I, II and III are structurally distinct in that the compounds of Group I are drawn to bicyclic heterocyclic compounds that do not contain an amide linkage. The compounds of Group II are drawn to dipeptides that do not contain a bi-cyclo ring system. The compounds of Group III are distinct from Group I and II in that the compounds utilize a disulfide linkage that is not present in the compounds of Group I and Group II. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III and vice versa, restriction for examination purposes as indicated is proper.
5. This application contains claims directed to the following patentably distinct species of the claimed invention:

For Group I, the species recited as 1(a)-16(a).

For Group II, the species recited as 1(b)-13(b).

For Group III, the species recited as 14(c)-16(c).

The species disclosed in each group are structurally distinct from one another. For example, the broad markush claim of Group I allows for substitutions such as N, O, S or CH₂ as the X variable in the hetero-ring. This substitutions of N, O, or S would be structurally distinct from a substitution of CH₂ since the N, O, or S would lead to a

hetero-ring containing two hetero atoms, while the substitution of CH₂ would lead a hetero-ring containing one hetero atom. Accordingly, the species disclosed are structurally distinct.

For the elected Group, Applicants are requested to elect a single disclosed species within the Group.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently:

For Group I, claims 1-17, 20-28 are generic.

For Group II, claims 33-39, 41-52, 57-58, 61-65 are generic.

For Group III, claims 53-55, 59-60, and 66-70 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (703) 308-4001. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can normally be reached on (703)308-2923. The fax phone number of this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Anish Gupta


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